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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,271	11/16/1999	STEPHAN MEYERS	6064-11	4110
32729	7590	06/28/2004	EXAMINER	
WAYNE DEMELLO NOKIA INC. 5 WAYSIDE ROAD BURLINGTON, MA 01803			NGUYEN, KEVIN M	
			ART UNIT	PAPER NUMBER
			2674	21

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/441,271

Applicant(s)

MEYERS ET AL.

Examiner

Kevin M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The request for reconsideration filed on 05/03/2004 has been fully considered but they are not persuasive. The rejections of claims 46-52 are maintained.

Specification

2. The disclosure is still objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 3, line 21, and page 9, line 1). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

It is suggested that the embedded hyperlink and/or other form of browser-executable code recited on page 3, line 8 and page 8, line 18 should be cited in the information disclosure statement.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 46, 47 and 49-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Redford et al "previously cited" (US 6,327,459).

As to claims 46 and 50, Redford et al teaches a hand-held portable electronic display device associated with a method, the hand-held portable electronic display

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device comprising a display A1-A7 (column 18, lines 26-32), a memory for storing a storage media in an encrypted format (an encrypted format is met protected information limitation of claim) associated with a first decryption code (see column 17, line 40), a removable cover (511,512) (column 17, lines 3-5); an identify reader (516) (a tag affixed, column 17, line 18) associated with a second decryption code; a printed circuit board (210) (a circuitry coupled with said display and with said memory, see figure 5L, column 20, lines 47-49);

during the mounting, a bar code pattern 521I (the first decryption code) printed on second portion 521B is read by the identify reader 516 (the second decryption code), thereby to determine/compare the first decryption code and the second decryption code (column 17, lines 32-34);

each of page marks 523A-523N (figure 5A), such as mark 523I (figure 5J) has identical printed content (e.g. "TOUCH AND VIEW®") (a touch display screen is an electronic display as claimed, column 18, lines 12-14). The user must touch a page mark 523I first, and thereafter touch one of areas A1-A7 to indicate the associated electronic content 13 (figure 1) to be displayed (column 18, lines 26-29).

As to claims 47 and 51, Redford et al teaches the hand-held portable electronic display device associated with the method comprising when a user removes the leaf 31 (figure 1) from the cover 32, during the removal process a button 202 (figure 7) is once again closed (put into code), thereby triggering (reset/clear 16, figure 7) a microcontroller 703 including the memory to read bar code pattern 113 (column 27, lines 27-30).

As to claim 49, Redford et al teaches a remote control (500) comprising the cover (511, 512) including the second decryption code is read by the identify reader (516) (said tag) using a wireless connection (see figure 5A, column 17, lines 3-6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 48 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redford et al in view of Munyan "previously cited" (US 5,761,485).

As to claim 48 and 52, Redford et al teaches all of the claimed limitations of claim 46, except for "a receiver for wirelessly receiving into said memory said protected information in an encrypted format and said first decryption code."

However, Munyan teaches a related hand-held portable electronic display device associated with a method, the hand-held portable electronic display device comprising a wireless (350) for wirelessly receiving into a memory (RAM), protected information (security identification code) in an encrypted format and a first decryption code (see figure 3, column 14, lines 33-36, and lines 59-64).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the wireless receiver (350) taught by Munyan for Redford et al's portable electronic display device because this would automatically access an on-line database service, automatically download selections from this database, and then store

these downloaded selections for later display by a user (column 4, lines 64-67 of Munyan), while reducing inventory, distribution and printing costs for publishers (column 4, lines 50-51 of Munyan).

Response to Arguments

7. Applicant's arguments filed 05/03/2004 have been fully considered but they are not persuasive.

8. In response to applicant's argument that claims 46 and 50 recite "the hand-held portable electronic display device includes a memory for storing protected information in an encrypted format."

This argument is not persuasive because Redford teaches

Recited on col. 20, lines 28-31

The two file-folder remote controls 500 and 550 are simple and easy to use because a booklet in the remote controls can be opened in the normal manner of a book (the hand-held portable device as claimed).

Recited on col. 7, lines 55-57

Fig. 11 illustrates, in a schematic circuit diagram, a remote control circuit included in the remote control of Fig. 4A.

Recited on col. 20, lines 1-15

In such an embodiment, remote control base 530 includes a memory (e.g. memory 1103M in FIG. 11) that is pre-programmed with an identity code (the protected information, an encrypt as claimed). Such an identity code is transmitted to host device 120 along with the position of a booklet mark, thereby to identify (the protected

information) the to-be-displayed information that is related to content printed in the booklet currently mounted in the remote control base (an electronic display as claimed). In one particular implementation, host device 120 translates the identity code (the protected information, an encrypt) into an Internet address at which the to-be-displayed information is available. Therefore, a user must first touch a booklet mark at top edge 540 or at bottom edge 540B to identify the currently mounted booklet. Thereafter the user uses the booklet in the above-described manner, e.g. touches one of page marks 543A-543N and an area e.g. area A1 (FIG. 5J) to pull up information related to article 1.

These argument are not persuasive because Redford teaches the identity code is used to scramble access codes to (computerized information) so as to prevent unauthorized access.

9. In response to applicant's argument that claims 47 and 51 recite "circuitry coupled with said display and with said memory capable of encrypting said protected information stored in said memory and clearing said protected information from said display if said cover is removed from said display." This argument is not persuasive because Redford et al teaches when a user removes the leaf 31 (figure 1) from the cover 32, during the removal process a button 202 (figure 7) is once again closed (put into code), thereby triggering (reset/clear 16, figure 7) a microcontroller 703 including the memory to read bar code pattern 113 (column 27, lines 27-30).

10. In response to applicant's argument that claims 48 and 52 recite "a receiver for wirelessly receiving into said memory said protected information in an encrypted format and said first decryption code." This argument is not persuasive because Redford

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teaches during the mounting, a bar code pattern 521I (the first decryption code) printed on second portion 521B is read by the identify reader 516 (the second decryption code), thereby to determine/compare the first decryption code and the second decryption code (column 17, lines 32-34). Munyan teaches a related hand-held portable electronic display device associated with a method, the hand-held portable electronic display device comprising a wireless (350) for wirelessly receiving into a memory (RAM), protected information (security identification code) in an encrypted format and a first decryption code (see figure 3, column 14, lines 33-36, and lines 59-64).

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Redford's hand-held portable electronic display device including the wireless receiver (350), in view of the teaching in Munyan's reference because this would automatically access an on-line database service, automatically download selections from this database, and then store these downloaded selections for later display by a user as taught by Munyan (col. 4, lines 64-67), while reducing inventory, distribution and printing costs for publishers as taught by Munyan (col. 4, lines 50-51).

For these reasons, the rejections based on Redford and Munyan have been maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kevin M. Nguyen** whose telephone number is **703-305-6209**. The examiner can normally be reached on MON-THU from 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard A Hjerpe** can be reached on **703-305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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or faxed to:

(703) 872-9306 (for Technology Center 2600 only)

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Kevin M. Nguyen
Patent Examiner
Art Unit 2674

KN
June 25, 2004


XIAO WU
PRIMARY EXAMINER